



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,991	11/20/2001	Gregory Luedtke	219002029100	1704

25225 7590 12/24/2002
MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130-2332

EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,991

Applicant(s)

LUEDTKE ET AL.

Examiner

Celia Chang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-68 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-68 are in the case.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 17-19, drawn to indolyl pyrrolidines, classified in class 548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Claims 13-16 reading on the elected compound can be prosecuted with the election to the extend of the election.
 - II. Claims 13-16 in part (not group I), drawn to indolyl cyclopentane, classified in class 548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required.
 - III. Claims 25-28, drawn to bicyclicpyrrolidine compounds, classified in class 548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Claims 20-24 reading on the elected compound can be prosecuted with the election to the extend of the election.
 - IV. Claims 20-24 in part (not group III), drawn to bicyclopentane, classified in class 548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required.
 - V. Claims 31-32, drawn to indolyl piperidines, classified in class 546, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Claims 29-30, 33-34 reading on the elected compound can be prosecuted together with the election to the extend of the election.

Art Unit: 1625

- VI. Claims 29-30, 33-34 in part (not group V), drawn to indolylcyclohexane, classified in class 548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required.
- VII. Claims 38-39, drawn to heterocyclic spiro compounds, classified in class 540-548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Claims 35-37 reading on the elected compounds can be prosecuted together with the elected compounds to the extent of the election.
- VIII. Claims 35-37 in part (not group VII), drawn to carbocyclic spiro compounds, classified in class 560-568, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required.
- IX. Claims 1-12, 40-62 in part (not groups I-VIII), drawn to remaining compounds, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Further restriction may be required.

The scope of claims 1-12, 40-62 reading on groups I-VIII will be prosecuted with each independent groups I-VIII to the extent of the election. Claims 63-68 can be prosecuted with each groups I-IX to the extent of the compounds of elect upon election of a species of condition encompassed in claim 68.

The inventions are distinct, each from the other because:

The claims are drawn to very complexed compounds lacking a common core structure. The compounds of groups I-IX differ in elements, chemical bonding and chemical properties to such an extend that without a species election, proper classification can not be ascertained. A reference anticipating any one of groups I-IX does not necessarily render another group obvious.

Art Unit: 1625

The search for each of groups I-IX is not required by another group, thus, are not coextensive. Each independent core structure for compounds of groups I-IX can support its own patent. Therefore, separate search and examination must be conducted.

Should applicant traverse on the ground that the groups and species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the groups and species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

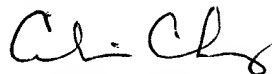
3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner can be reached by facsimile at (703) 308-7922 with courtesy voice message supra.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

OACS/Chang
Dec. 20, 2002


Celia Chang
Primary Examiner
Art Unit 1625